

**REMARKS**

**I. Status of Claims**

By this Amendment, Applicants have amended claims 1, 5, 32, 39, 44, 45, 48, and 49. Claims 1-25 and 27-61 are pending.

In the last Office Action, the Examiner:

- (a) rejected claims 31 and 49 under 35 U.S.C. § 112, ¶ 1 for allegedly failing to comply with the enablement requirement;
- (b) rejected claims 1-25 and 27-61 under 35 U.S.C. § 112, ¶ 2 as allegedly indefinite;
- (c) rejected claims 1-25 and 27-61 under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter;
- (d) rejected claims 31-38, 49, 57, 60, and 61 under 35 U.S.C. § 102(e) over U.S. Patent Application Publication No. US2002/0054714 ("*Hawkins*");
- (e) rejected claims 1-24, 27-30, 48, and 50-56 under 35 U.S.C. § 103(a) over *Hawkins* and International Publication No. WO 01/87245 ("*Marapane*");
- (f) rejected claims 45-47 under 35 U.S.C. § 103(a) over International Publication No. WO 01/18674 ("*Maloney*") and *Marapane*;
- (g) rejected claim 25 under 35 U.S.C. § 103(a) over *Hawkins*, *Marapane*, and AS/400 Redbook Softcopy Library CD Image ("*Redbook Image*"); and

(h) rejected claims 39-44, 58, and 59 under 35 U.S.C. § 103(a) over  
*Maloney*.

**II. Rejection of Claims 31 and 49 under 35 U.S.C. § 112, ¶ 1**

Applicants respectfully traverse the rejection of claims 31 and 49 under 35 U.S.C. § 112, ¶ 1 for allegedly failing to comply with the enablement requirement.

The standard for determining whether the specification meets the enablement requirement is whether undue or unreasonable experimentation is needed to practice an invention. M.P.E.P. § 2164.01 (8th Ed. August 2005). The Patent Office has the burden of establishing a reasonable basis to question the enablement provided for the claimed invention. *Id.*, § 2164.04. Further, any analysis of whether a particular claim is enabled requires a determination of whether the specification, when filed, contained sufficient information regarding the subject matter of the claims to enable one skilled in the art to make and use the claimed invention. *Id.*, § 2164.01.

In this instance, the Office Action provides no evidence demonstrating why one skilled in the art would not be able to prescribe a product and does not present any reasonable basis on why one skilled in the art would not be able to understand the meaning of prescribing a product. It is the Patent Office's burden to establish such a reasonable basis to question the enablement provided for the claimed invention. Applicants contend that one skilled in the art would be able practice the feature of prescribing a product without undue experimentation and the Patent Office has not provided any evidence to the contrary.

On page 3 of the Office Action, the Examiner asserts that claims 31 and 49 contain subject matter that is allegedly not described in the specification in such a way

as to enable one skilled in the art to make and/or use the invention. The Examiner alleges that prescribing a cosmetic product to the subject is not described in the specification. However, Applicants note that paragraph [048] on page 14 and paragraph [073] on page 24 of the specification describe providing product prescriptions or prescribing products, such as, for example, anti-wrinkle cream, to treat a subject's external condition. Thus, one skilled in the art would be enabled at least by this disclosure to practice the inventions in claims 31 and 49.

Accordingly, the rejection of claims 31 and 49 under 35 U.S.C. § 112, ¶ 1 should be withdrawn because a prima facie case for lack of enablement has not been established for at least the above reasons.

### **III. Rejection of Claims 1-25 and 27-61 under 35 U.S.C. § 112, ¶ 2**

Applicants respectfully traverse the rejection of claims 1-25 and 27-61 under 35 U.S.C. § 112, ¶ 2 as allegedly indefinite.

On page 3 of the Office Action, the Examiner asserts that claims 1, 5, 31, 39, 44-46, 48, and 50 are allegedly indefinite because those claims allegedly recite methods for "beauty care," "beauty tracking," beauty advisory," or "beauty analysis" and it is allegedly not clear what the term "beauty" contemplates. First, Applicants note that claims 31 and 50 do not recite methods for "beauty care," "beauty tracking," beauty advisory," or "beauty analysis." Claims 31 and 50 recite methods for recording beauty information. Accordingly, the Examiner's allegations regarding claims 31 and 50 are incorrect, and the Examiner has not presented a prima facie case with respect to those claims being allegedly indefinite.

Secondly, Applicants respectfully disagree with the Examiner and submit that one skilled in the art would understand the meaning of claims 1, 5, 31, 39, 44-46, 48, and 50, upon reading those claims. Further, definiteness of a claim must be analyzed, not in a vacuum, but in light of the content of the application disclosure. M.P.E.P.

§ 2173.02. As discussed in Applicants' specification, "beauty" refers to external body conditions and characteristics, including but not limited to skin, hair, nail, or other body conditions, or any other aesthetic-related, physical, physiological, or biological conditions of the user. Paragraphs [088] and [094] to [097] on pages 31, 35, and 36 of the specification illustrate the meaning of "beauty" as it might relate to "beauty products," "beauty care," "beauty tracking," beauty advisory," or "beauty analysis."

Accordingly, for at least the above reasons, one skilled in the art would not find the term "beauty" vague or indefinite.

On page 4 of the Office Action, the Examiner alleges that claims 1, 5, 31, 32, 39, 44-46, and 48-50 are indefinite for using the terms "facilitating," "enabling," "encouraging," "prescribing," "associating," "instructing," and "causing." First, Applicants note that claim 50 does not use any of those terms. Claim 50 merely recites "providing information . . . , " "providing instructions . . . , " and "establishing a subject record . . . ." Accordingly, the Examiner's allegations regarding claim 50 are incorrect, and the Examiner has not presented a prima facie case of alleged indefiniteness with respect to claim 50.

Secondly, Applicants respectfully disagree with the Examiner and submit that one skilled in the art would understand the meaning of claims 1, 5, 31, 32, 39, 44-46, and 48-50, upon reading those claims. Further, as previously mentioned, definiteness

of claim language must be analyzed, not in a vacuum, but in light of the content of the application disclosure. M.P.E.P. § 2173.02. In view of the specification, one skilled in the art would understand the meaning of claims 1, 5, 31, 32, 39, 44-46, and 48-50. For instance, paragraphs [089] to [093] on pages 32-35 of the specification illustrate the meaning of the terms "facilitating," "enabling," "encouraging," "prescribing," "associating," "instructing," and "causing." Accordingly, for at least the above reasons, one skilled in the art would not find those terms vague or indefinite.

On page 4 of the Office Action, the Examiner alleges that the preambles in claims 1, 5, 32, 39, 44, 45, 48, and 49 do not correspond to the bodies of those claims. Applicants respectfully disagree with the Examiner and point out that the preambles of those claims are not inconsistent with the bodies of those claims. However, in order to advance the prosecution of this case, Applicants have amended claims 1, 5, 32, 39, 44, 45, 48, and 49, without narrowing their scope, to remove any preamble language at issue. Accordingly, the Examiner's concerns about the preambles in claims 1, 5, 32, 39, 44, 45, 48, and 49 are moot.

For at least the above reasons, Applicants respectfully traverse the rejection of claims 1-25 and 27-61 under 35 U.S.C. § 112, ¶ 2 as allegedly indefinite, and request withdrawal of the rejection.

#### **IV. Rejection of Claims 1-25 and 27-61 under 35 U.S.C. § 101**

Applicants respectfully traverse the rejection of claims 1-25 and 27-61 under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter.

On pages 5 and 6 of the Office Action, the Examiner alleges that the inventions in claims 1-25 and 27-61 are non-statutory because they allegedly do not provide

(1) useful and (2) tangible results. Regarding the first point, Applicants point out that the inventions in claims 1-25 and 27-61 provide useful results. For example, claim 1 recites:

1. A method, comprising:
  - obtaining first information representative of an external body condition of a subject;
  - obtaining second information representative of the external body condition of the subject after the subject uses a beauty product;
  - facilitating storage of information reflecting the subject's usage of the beauty product; and
  - enabling the subject to view the first information, the second information, and at least part of the stored information.

Hence, the invention in claim 1 enables a subject to view first information, second information, and at least part of stored information, reflecting the subject's usage of a beauty product. This is a useful result in and of itself because it enables the subject to view information on the subject's usage of the beauty product. Additionally, as disclosed in the specification at paragraphs [002] to [005], another useful result is that it allows a subject to track the progress and evaluate the effectiveness of the beauty product. As stated by the Examiner on page 5 of the Office Action, "utility need not be expressly recited in the claims, rather it may be inferred." In this instance, both claim 1 and the specification expressly disclose useful applications.

Regarding the second point, Applicants point out that the inventions in claims 1-25 and 27-61 provide tangible results. For example, as discussed above, the invention in claim 1 enables a subject to view first information, second information, and at least

part of stored information, reflecting the subject's usage of a beauty product. Further, as disclosed in the specification, the invention in claim 1 can also allow a subject to track the progress and evaluate the effectiveness of the beauty product. These are clearly tangible results and the Examiner has not provided any evidence to the contrary. Indeed, on page 5 of the Office Action, the Examiner quotes *In re Warmerdam* for a test of evaluating whether an invention provides tangible results. According to the Examiner, the test is allegedly whether there is a mathematical construct claimed. Even by this standard, Applicants note that claim 1 does not claim a mathematical construct, and hence, claim 1 provides tangible results.

Additionally, on page 6 of the Office Action, the Examiner states that "facilitating," "enabling," "encouraging," "prescribing," "associating," "instructing," and "causing" are allegedly vague and indefinite, and therefore claims containing those terms allegedly do not provide useful and/or tangible results. Applicants submit that those terms are not vague or indefinite as previously discussed above in response to the rejection under 35 U.S.C. § 112, ¶ 2. Accordingly, the claims including those terms provide useful and tangible results.

For at least the above reasons, claim 1 is directed to statutory subject matter. Further, remaining claims 2-25 and 27-61 are also directed to statutory subject matter for reasons similar to the ones discussed above for claim 1. That is, claims 2-25 and 27-61 and/or the specification disclose useful and tangible results that are provided by the inventions in those claims. Hence, the rejection of claims 1-25 and 27-61 under 35 U.S.C. § 101 is without merit and should be withdrawn.

**V. Rejection of Claims 31-38, 49, 57, 60, and 61 under 35 U.S.C. § 102(e)**

Applicants respectfully traverse the rejection of claims 31-38, 49, 57, 60, and 61 under 35 U.S.C. § 102(e) over *Hawkins* because the cited reference fails to teach each and every limitation in the claims.

*Hawkins* discloses applying a cosmetic product to a body, capturing an image of a consumer, displaying the image on a monitor, and digitally transforming the image to reflect the effect of using the selected cosmetic product over a period of time. *Hawkins*, Abstract. Glow, color, sags, wrinkles, and pores are among the attributes that are transformed in the image. *Id.* The original and transformed images are juxtaposed on a screen, and the consumer selects between the images until the consumer has chosen her most appealing transformation. *Id.*

With respect to claim 31, *Hawkins* fails to teach at least “establishing a subject record, the record including the first image,” “associating the at least one second image with the subject record,” and “providing the subject with viewing access to the subject record,” as recited in the claim. *Hawkins* does not mention these “establishing . . . ,” “associating . . . ,” and “providing . . .” features in claim 31 and the Examiner has not provided any evidence to the contrary. Indeed, as shown on page 7 of the Office Action, the Examiner does not even address these features of claim 31.

Further, in the Office Action, the Examiner appears to discuss limitations that are not recited in claim 31. For example, at the first paragraph on page 7 of the Office Action, the Examiner refers to “digitally transforming the captured images to demonstrate effects of use of the cosmetic product” and “displaying captured and transformed images to the user.” Applicants note that claim 31 does not recite “digitally



transforming the captured images to demonstrate effects of use of the cosmetic product" or "displaying captured and transformed images to the user." Accordingly, for at least the above reasons, the rejection of claim 31 under 35 U.S.C. § 102(e) over *Hawkins* should be withdrawn, and claim 31 should be allowed.

With respect to claims 32-38 and 57, *Hawkins* fails to teach at least "distributing at least one cosmetic product to the beauty facility," "instructing the beauty facility to capture images of the external body condition before and after application of the at least one cosmetic product," and "instructing the beauty facility to display to the customer the before and after images so that the customer may be provided with a visual indication of progress," as recited in independent claim 32 and required by its dependent claims 33-38 and 57. On page 7 of the Office Action, the Examiner alleges that "[s]electing the cosmetic product at the sales counter . . . inherently indicates *distributing* said cosmetic product to the point of sale [and] . . . stipulates that without instructing said operator how to conduct said method prior to said 'assisting' the subject, said operator would not be able to conduct said method." However, the Examiner has not established that *Hawkins* discloses the above noted features of claims 32-38 and 57. Further, the Examiner has not established inherency.

As M.P.E.P. § 2112 makes clear:

To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." (internal citations omitted).

In addition, M.P.E.P. § 2112 states:

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. (internal citations omitted).

In this case, the Final Office Action fails to provide sufficient evidence from *Hawkins*, or any extrinsic evidence, that makes clear that the subject matter of claims 32-38 and 57 is necessarily present in the reference. Further, the Final Office Action fails to present sufficient factual basis and technical reasoning to demonstrate inherency. That *Hawkins* allegedly mentions “[s]electing the cosmetic product at the sales counter” does not demonstrate that the recitation of “distributing at least one cosmetic product to the beauty facility” is necessarily present in *Hawkins*. For example, “[s]electing the cosmetic product at the sales counter” may be done without “distributing at least one cosmetic product to the beauty facility.”

In addition, the Final Office Action provides no factual basis and technical reasoning to support the allegation that use of *Hawkins*'s method indicates instructing a business entity to perform the claimed method. Consequently, the Examiner cannot properly infer that the subject matter of claims 32-38 and 57 is inherently disclosed by *Hawkins*. For at least these reasons, the rejection of claims 32-38 and 57 under 35 U.S.C. §102(e) based on *Hawkins* should be withdrawn, and claims 32-38 and 57 should be allowed.

With respect to claims 49, 60, and 61, *Hawkins* fails to teach at least “analyzing the first and second information to determine an extent of differences that occurred in the body condition between the first and second time frames” and “prescribing at least one beauty product based on the extent of determined differences,” as recited in

independent claim 49 and required in its dependent claims 60 and 61. Although *Hawkins* at paragraph [0042] mentions allowing a consumer to compare results between images, this is not the same as and does not constitute “analyzing first and second information to determine an extent of differences that occurred in the body condition,” as claimed. Further, digitally transforming an image to demonstrate predicted effects of a cosmetic product treatment, as disclosed by *Hawkins* at paragraphs [0043] and [0044], does not anticipate “analyzing . . . first and second information to determine an extent of differences that occurred in the body condition,” as claimed. Specifically, in *Hawkins*’s system, an image is digitally transformed to demonstrate a predicted effect, not to analyze information to determine an extent of differences that occurred in the body condition. Additionally, giving customized product information to a consumer to help achieve the ideal in a digitally transformed image that demonstrates predicted effects of a cosmetic product treatment, as disclosed by *Hawkins* at paragraph [053], is not the same as and does not constitute prescribing at least one beauty product based on the extent of determined differences that occurred in the body condition between the first and second time frames, as claimed. Accordingly, the rejection of claims 49, 60, and 61 under 35 U.S.C. § 102(e) is unsupported by *Hawkins* and should be withdrawn.

**VI. Rejection of Claims 1-24, 27-30, 48, and 50-56 under 35 U.S.C. § 103(a)**

Applicants respectfully traverse the rejection of claims 1-24, 27-30, 48, and 50-56 under 35 U.S.C. § 103(a) over *Hawkins* and *Marapane* because the cited references fail to teach or suggest, separately or in combination, each and every element in the claims.

With respect to claims 1-4 and 53, *Hawkins* and *Marapane* fail to teach or suggest at least “enabling the subject to view the first information, the second information, and at least part of the stored information,” as recited in independent claim 1 and required in its dependent claims 2-4 and 53. *Hawkins* merely discloses juxtaposing original and transformed images on a screen. *Hawkins*, Abstract. *Marapane* merely discloses a screen that asks a recipient how often he/she has colored his/her hair over the past year and states that the frequency to which someone colors his/her hair may affect the hair’s condition and ability to receive another coloring. *Marapane*, p. 4, lines 16-18. Neither of these disclosures in *Hawkins* and *Marapane* teaches or suggests, separately or in combination, “enabling the subject to view the first information, the second information, and at least part of the stored information” (emphasis added).

Further, there is no motivation to combine *Hawkins* and *Marapane* to yield the invention in claims 1-4 and 53. On page 9 of the Office Action, the Examiner alleges that it would have allegedly been obvious to modify *Hawkins* because it is allegedly advantageous to allow estimation of a subject’s body condition and ability to receive another coloring. However, this alleged motivation would not have caused any hypothetical combination of *Hawkins* and *Marapane* to yield the inventions in claims 1-4 and 53. Specifically, even if it were advantageous to allow estimation of a subject’s body condition and ability to receive another coloring (which has not been demonstrated), that alleged motivation would only yield a hypothetical system for juxtaposing original and transformed images on a screen as disclosed in *Hawkins*, and asking a recipient how often he/she has colored his/her hair over the past year as

disclosed in *Marapane*. That alleged motivation does not demonstrate why one would combine *Hawkins* and *Marapane* to (1) obtain first information representative of an external body condition of a subject, (2) obtain second information representative of the external body condition of the subject after the subject uses a beauty product, (3) facilitate storage of information reflecting the subject's usage of the beauty product, and (4) enable the subject to view the first information, the second information, and at least part of the stored information, as required by claims 1-4 and 53.

In view of the above, it appears that the Examiner is using hindsight reasoning to reconstruct the inventions in claims 1-4 and 53 from the prior art. This is improper. The Federal Circuit has specifically admonished the use of "the inventor's disclosure as a blueprint" in hindsight. *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999), *abrogated on other grounds by In re Gartside*, 203 F.3d 1305, 53 USPQ2d 1769 (Fed. Cir. 2000). The court has further warned that an "inventor's explanation of how the invention works does not render obvious that which is otherwise unobvious." *In re Glaug*, 283 F.3d 1335, 1342, 62 USPQ2d 1151, 1155 (Fed. Cir. 2002). These admonitions and warnings are "especially important in the case of less technically complex inventions, where the very ease with which the invention can be understood may prompt one to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617 (quotation omitted).

Accordingly, for at least the above reasons, the rejection of claims 1-4 and 53 under 35 U.S.C. § 103(a) over *Hawkins* and *Marapane* should be withdrawn.

With respect to claims 5-24, 27-30, and 54-56, *Hawkins* and *Marapane* fail to teach or suggest at least “enabling the subject to view the first image, the second image, and the stored information on a display device, to thereby visually observe changes that occurred between times when the first and second images were captured,” as recited in independent claim 5 and required by its dependent claims 6-24, 27-30, and 54-56. While claims 5-24, 27-30, and 54-56 are of different scope than claims 1-4 and 53, *Hawkins* and *Marapane* do not teach or suggest the “enabling the subject to view . . .” feature of claims 5-24, 27-30, and 54-56 for at least reasons similar to those presented above for claims 1-4 and 53. Further, there is no motivation to combine *Hawkins* and *Marapane* to yield the inventions in claims 5-24, 27-30, and 54-56 for at least reasons similar to those presented above for claims 1-4 and 53. Accordingly, the rejection of claims 5-24, 27-30, and 54-56 under 35 U.S.C. § 103(a) over *Hawkins* and *Marapane* should be withdrawn, and claims 5-24 and 27-30 should be allowed.

With respect to claim 48, *Hawkins* and *Marapane* fail to teach or suggest at least “enabling the subject to view the first image, the second image, and the stored information on a display device, to thereby visually observe changes that occurred between times when the first and second images were captured,” as recited in the claim. While claim 48 is of different scope than claims 1-4 and 53, *Hawkins* and *Marapane* do not teach or suggest the “enabling the subject to view . . .” feature of claim 48 for at least reasons similar to those presented above for claims 1-4 and 53. Further, there is no motivation to combine *Hawkins* and *Marapane* to yield the invention in claim 48 for at least reasons similar to those presented above for claims 1-4 and 53.

With respect to claims 50-52, *Hawkins* and *Marapane* fail to teach or suggest at least "providing instructions for storage of third information relating to behavior of a subject between the first and second time frames," and "establishing a subject record, the record including the first, second and third information, wherein the subject is enabled to maintain control of the subject record," as recited in independent claim 50 and required in its dependent claims 51 and 52. On page 11 of the Office Action, the Examiner admits that *Hawkins* does not disclose the "providing instructions for storage of third information . . ." and "establishing a subject record . . ." features, and attempts to correct *Hawkins*'s deficiencies with *Marapane*. Specifically, the Examiner alleges that page 8, lines 8-10 of *Marapane* teach the "providing instructions for storage of third information . . ." and "establishing a subject record . . ." features. However, page 8, lines 8-10 of *Marapane* merely state:

After these initial readings were taken, the consumer's hair was colored using a shade selected by the consumer. After coloring and drying, the color of the hair was taken again using the colorimeter as outlined above.

This is not the same as and does not suggest providing instructions for storage of third information relating to behavior of a subject between first and second time frames, and establishing a subject record, the record including the first, second and third information, wherein the subject is enabled to maintain control of the subject record.

Accordingly, the rejection of claims 50-52 under 35 U.S.C. § 103(a) over *Hawkins* and *Marapane* should be withdrawn, and claims 50-52 should be allowed.

**VII. Rejection of Claims 45-47 under 35 U.S.C. § 103(a)**

Applicants respectfully traverse the rejection of claims 45-47 under 35 U.S.C. § 103(a) over *Maloney* and *Marapane* because the cited references fail to teach or suggest, separately or in combination, each and every element in the claims.

With respect to claim 45, *Maloney* and *Marapane* fail to teach or suggest at least “enabling the data structure to maintain a historical record of at least some of the recorded cosmetic product usage information and personal information,” and “causing at least one product to be recommended to the individual, wherein the at least one product recommendation is generated using at least a portion of the historical record,” as recited in the claim. *Maloney* merely discloses providing a customized product to a consumer. *Maloney*, Fig. 1, p. 6. The customized product is selected from a list of products provided to the consumer based on a profiling category of the consumer, which is determined by collecting consumer profiling data. *Id.*, at 7. *Marapane* merely discloses a screen that asks a recipient how often he/she has colored his/her hair over the past year and states that the frequency to which someone colors his/her hair may affect the hair’s condition and ability to receive another coloring. *Marapane*, p. 4, lines 16-18. Neither of these disclosures in *Maloney* and *Marapane* teaches or suggests, separately or in combination, “enabling the data structure to maintain a historical record of at least some of the recorded cosmetic product usage information and personal information,” and “causing at least one product to be recommended to the individual, wherein the at least one product recommendation is generated using at least a portion of the historical record” (emphasis added).



On page 13 of the Office Action, the Examiner appears to allege that page 12, lines 15 and 16 of *Maloney* purportedly teaches “causing at least one product to be recommended to the individual, wherein the at least one product recommendation is generated using at least a portion of the historical record.” However, page 12, lines 15 and 16 of *Maloney* merely discloses that “[p]referably, every interaction is followed by feedback data which is then utilized to learn the consumer’s preferences and optimize the consumer’s experience.” Applicants note that this is not the same as and does not suggest “causing at least one product to be recommended to the individual, wherein the at least one product recommendation is generated using at least a portion of the historical record,” as recited in claim 45.

On page 14 of the Office Action, the Examiner appears to admit that *Maloney* does not teach “enabling the data structure to maintain a historical record of at least some of the recorded cosmetic product usage information and personal information,” and then attempts to rely on *Marapane* for this “enabling the data structure . . .” feature. However, as mentioned above, *Marapane* merely discloses a screen that asks a recipient how often he/she has colored his/her hair over the past year and states that the frequency to which someone colors his/her hair may affect the hair’s condition and ability to receive another coloring. *Marapane*, p. 4, lines 16-18. This is not the same as and does not suggest “enabling the data structure to maintain a historical record of at least some of the recorded cosmetic product usage information and personal information,” as recited in claim 45.

Accordingly, for at least the above reasons, the rejection of claim 45 under 35 U.S.C. § 103(a) over *Maloney* and *Marapane* should be withdrawn, and claim 45 should be allowed.

With respect to claims 46 and 47, *Maloney* and *Marapane* fail to teach or suggest at least “causing, when the subject’s cosmetic usage is inconsistent with the cosmetic usage of individual’s with lifestyles similar to the subject’s lifestyle, at least one product to be recommended to the subject,” as recited in independent claim 46 and required by its dependent claim 47. *Maloney* merely mentions determining a profiling category for a consumer based on profiling information and providing a list of products corresponding to the category. *Maloney*, p. 7 and 9. On page 14 of the Office Action, the Examiner appears to indicate that page 7, lines 13 and 14 of *Maloney* allegedly discloses the “causing, when the subject’s cosmetic usage is inconsistent . . .” feature. However, page 7, lines 13 and 14 of *Maloney* merely discloses “The consumer is provided a list of one or more products (40) that correspond to the consumer profile category.” This is not the same as and does not suggest “causing, when the subject’s cosmetic usage is inconsistent with the cosmetic usage of individual’s with lifestyles similar to the subject’s lifestyle, at least one product to be recommended to the subject” (emphasis added).

Further, *Marapane*, separately or in combination, does not cure the deficiencies of *Maloney*. *Marapane* merely discloses asking a recipient how often he/she has colored his/her hair over the past year and stating that the frequency to which someone colors his/her hair may affect the hair’s condition and ability to receive another coloring. *Marapane*, p. 4, lines 16-18.

Accordingly, for at least the above reasons, the rejection of claims 46 and 47 under 35 U.S.C. § 103(a) over *Maloney* and *Marapane* should be withdrawn, and claims 46 and 47 should be allowed.

**VIII. Rejection of Claim 25 under 35 U.S.C. § 103(a)**

Applicants respectfully traverse the rejection of claim 25 under 35 U.S.C. § 103(a) over *Hawkins*, *Marapane*, and *Redbook Image* because cited references fail to teach or suggest, separately or in combination, each and every element in the claims. Claim 25 depends upon independent claim 5 and includes all limitations of claim 5. As discussed above for claim 5, *Hawkins* and *Marapane* fail to teach or suggest, separately or in combination, at least “enabling the subject to view the first image, the second image, and the stored information on a display device, to thereby visually observe changes that occurred between times when the first and second images were captured,” as recited in claim 5 and required by its dependent claim 25. *Redbook Image* fails to cure these deficiencies of *Hawkins* and *Marapane*. *Redbook Image* is merely a photocopy image of the front of a CD disc, and does not teach “enabling the subject to view the first image, the second image, and the stored information on a display device, to thereby visually observe changes that occurred between times when the first and second images were captured.” Accordingly, for at least the above reasons, the rejection of claim 25 under 35 U.S.C. § 103(a) over *Hawkins*, *Marapane*, and *Redbook Image* should be withdrawn, and claim 25 should be allowed.

**IX. Rejection of Claims 39-44, 58, and 59 under 35 U.S.C. § 103(a)**

Applicants respectfully traverse the rejection of claims 39-44, 58, and 59 under 35 U.S.C. § 103(a) over *Maloney* because cited reference fails to teach or suggest each and every element in the claims.

With respect to claims 39-43 and 58, the Examiner concedes that *Maloney* fails to disclose “a transportable computer-readable media.” Office Action, p. 16. In rejecting claim 39 and its dependent claims 40-43 and 58, the Examiner alleges that “[i]t is old and well known that computer-readable media can be . . . transportable.” *Id.* The Examiner further alleges that a skilled artisan would have modified *Maloney* to allow a subject to record personal beauty information on a transportable medium “because it would advantageously allow . . . use [of] this method in geographical locations where network communication is not available.” The Examiner has not established the requisite motivation to modify *Maloney*, as discussed below.

The Office Action does not show that a skilled artisan considering *Maloney*, and not having the benefit of Applicants’ disclosure, would have been motivated to modify *Maloney*’s system in a manner resulting in Applicants’ claimed combination. The allegations by the Examiner regarding motivation are completely conclusory and unsupported by any evidence on the record. For example, the Examiner points to no mention in *Maloney* of the alleged use “in geographical locations where network communication is not available.” Further, the Examiner provides no evidence or reasoning showing that transportable medium would allow use of *Maloney*’s method “in geographical locations where network communication is not available.”

Even if transportable computer-readable media were old and well known, as alleged by the Examiner, *prima facie* obviousness has not been established. Section 2141.02 of the M.P.E.P. makes clear that “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious” (internal citations omitted). Assuming *arguendo* that transportable computer-readable media were obvious or well known, the Examiner failed to establish that claim 39 as a whole, including “enabling a subject to record personal beauty information on a transportable medium” and “enabling a plurality of beauty facilities to read the information on the transportable medium, and to update the information when the subject visits one or more of the plurality of beauty facilities,” would have been obvious. Applicants submit that the Examiner is improperly using Applicants’ claims in hindsight to reconstruct the prior art.

For at least the reasons above, *prima facie* obviousness has not been established with respect to claim 39 and its dependent claims 40-43 and 58. Hence, the rejection of claims 39-43 and 58 under 35 U.S.C. § 103(a) over *Maloney* should be withdrawn, and claims 39-43 and 58 should be allowed.

With respect to claims 44 and 59, which have a scope different from claims 39-43 and 58, *prima facie* obviousness has not been established for at least reasons similar to those set forth above for claims 39-43 and 58. Accordingly, the rejection of claims 44 and 59 under 35 U.S.C. § 103(a) over *Maloney* should be withdrawn, and claims 44 and 59 should be allowed.

**CONCLUSION**

Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

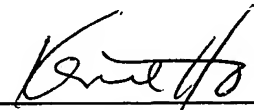
Applicants note that the Office Action contains numerous statements reflecting apparent assertions concerning the related art and claims. Regardless of whether any such statement is addressed specifically herein, Applicants decline to automatically subscribe to any assertion and/or characterization set forth in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: July 11, 2006

By:   
Kenie Ho  
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